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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,557	02/20/2001	Cesare Bisleri	05788.0156	3504

22852 7590 08/19/2003

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EXAMINER

THOMPSON, CAMIE S

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 08/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,557

Applicant(s)

BISLERI ET AL.

Examiner

Camie S Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 10 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-67 and 83-99 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-67 and 83-99 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 10, 2003 has been entered.
2. Examiner acknowledges amended claims 53 and 83.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 53-67 and 83-99 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has pointed to the specification at page 3, lines 7-11 for support that the inner layer does not comprise an effective amount of a fire retardant agent; however, that portion of the specification merely refers to the covering layer. No support is seen for an inner layer as presently claimed. Further, deletion of an element to avoid a reference is not proper.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 53-67 and 83-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caimi, U.S. Patent Number 6,339,189 in view of Castellani et al., U.S. Patent Number 6,162,548.

The Caimi reference is drawn to a low-tension, electrical cable that has fire retardant and moisture resistant properties that includes a metal conductor and at least a double layer polymer coating disposed to surround the metal conductor as per instant claims 53 and 83 (see abstract, column 1, lines 15-20 and column 4, lines 33-43). The reference also discloses that the inner layer comprises a polymer matrix wherein the polymer maybe a polyolefin such as polyethylene and the inner layer has moisture resistant properties as per instant claims 53, 56-57, 83 and 86-87 (see column 4, lines 45-49 and column 8, lines 50-68). The outer layer is disclosed by the Caimi reference as comprising a base polymer matrix such as the copolymer polypropylene and a diene such as 1,3 butadiene wherein an inorganic charge such as magnesium hydroxide is dispersed in the copolymer and diene mixture to provide with the desired fire-resistance properties as per instant claims 58-64 and 88-94 (see column 4, lines 49-68 and column 6, lines 32-column 7, line 10). The reference also discloses that the outer layer contains a limited amount of coupling agent such as an unsaturated silane or ethylenically unsaturated carboxylic groups as per instant claims

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66-67 and 96-97 (see column 5, lines 31-38 and column 6, lines 32-68). Caimi discloses that the thickness of the inner layer is at least 0.4 mm while the outer layer thickness is preferably greater than 0.2mm as per instant claims 53-55 and 83-85 (see column 10, lines 15-28). Caimi also discloses that the amount of magnesium hydroxide in the outer layer may range from 20% to 90% by weight as per instant claims 65 and 95 (see column 6, lines 32-46). The cable is disclosed in the reference as being found in such adverse work conditions such as electrical and petrolchemical plants where there is a question of fire safety as per instant claim 99 (see column 9, lines 46-51). Also, the cable is disclosed as being advantageous in cables for power transmission that would be located outside and may be subject to wet weather conditions as per instant claim 98 (see column 9, lines 39-45). The Caimi reference does not disclose that the inner layer is free of an effective amount of a fire retardant agent. Castellani teaches an electrical cable comprises a conductor and one or more coating layers, wherein at least one of the coating layers has electrical insulating properties such as low water absorption and one of the coating layers is an outer protective sheath (see column 2, lines 40-55). Castellani discloses that at least one of the layers comprises a non-crosslinked based polymer wherein the material comprises a crystalline propylene homopolymer and an elastomeric copolymer of ethylene with at least one alpha-olefin and optionally with a diene wherein the alpha-olefin may be propylene and the optional diene may be 1,3-butadiene. The Castellani reference discloses that one of the coating layers does not have to a fire retardant agent. Castellani does disclose that one of the coating layers has an inorganic filler such as magnesium hydroxide. The Castellani reference discloses that the insulating layer avoids excessive reduction of electrical resistivity and has reduced dielectric loss without a fire retardant agent. Therefore, it would have been obvious to one of

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ordinary skill in the art to have the inner layer of the Caimi reference without the presence of a fire retardant agent so as to have an inner layer that has low water absorption in order to achieve lower energy dissipation levels and enhanced electrical performance as shown in column 5, lines 14-20 of the Castellani reference.

The method of passing electricity through a cable in claims 83-99 only recites the features of the fire and water resistant, low-voltage electrical cable and so Caimi and Castellani read on the method claims, 83-99, also:

Response to Arguments

7. Applicant's arguments with respect to claims 53-67 and 83-99 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (703) 305-4488. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly, can be reached at (703) 308-0449. The fax phone number for official papers is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


Camie Thompson


DEBORAH JONES
SUPERVISORY PATENT EXAMINER